



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/089,131 | 03/25/2002 | Tomaya Hidaka | 1576.100 | 2506 |

24040 7590 01/15/2004
MASON & ASSOCIATES, PA
17757 US HWY 19 N.
SUITE 500
CLEARWATER, FL 33764

EXAMINER

KUMAR, SHAILENDRA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1621

DATE MAILED: 01/15/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,131

Applicant(s)

HIDAKA ET AL.

Examiner

SHAIENDRA - KUMAR

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

This office action is in response to the notice of withdrawal from the issue of the instant case, filed in paper # 12, and hence the prosecution is reopened.

Claims 1-6 are pending in this application.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al(US 4,075,227).

Jones et al, column 11, line 3, anticipates instant claim, when in the instant claim, R1 and R2 are hydrogen, t is 0, R4 is methoxy, n is 0, m is 0, Y is CO, q is 0, p is 1.

Claim Rejections - 35 USC § 103

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al(US 5,614,357) or Tsuchiya et al(US 4,988,662).

Lau et al, column 6, lines 30-50, teach structurally similar compounds as claimed herein, note Z can be hydrogen, X can be halogen, R3 can be alkyl, R7 can be hydroxy, and R4 and R5 can be hydrogen or alkyl, or Tsuchiya et al, column 2, compound (I), teach structurally similar compound as claimed herein, when Y1 can be hydroxy, X1 can be sulfur, R5 can be phenyl substituted with hydroxy. The difference between the references and herein claimed compounds is that the references have not made specific compounds as disclosed herein.

Art Unit: 1621


It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the references, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful thermo recording sheet or photographic element, absent evidence to the contrary.

4. Claims 2-6 are free of prior art and are allowable.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is 703-308-4519. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SHAILENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
1/13/04